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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,433	04/06/2001	Thomas Brumm	112740-211	6084
29177	7590	06/30/2005		EXAMINER
BELL, BOYD & LLOYD, LLC				ELALLAM, AHMED
P. O. BOX 1135				
CHICAGO, IL 60690-1135			ART UNIT	PAPER NUMBER
			2662	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/827,433	BRUMM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	AHMED ELALLAM	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 07 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

This office action is responsive to Amendment filed on 3/7/2005. The amendment has been entered.

***Drawings***

1. The drawings of figure 4 are objected to because signal S14 is shown to be going from the central office to telephone set 32, while in the specification it is indicated that S14 is transmitted to the control unit 14, see specification page 13, lines 18-21. Also, the drawings of figures 1-5 are objected to because the descriptive labels and the interconnections between lines within the boxes 12-18 are not shown due the heavily shaded patterns. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the meaning of claimed "first signaling information, which in the circuit-switching communication network, are configured according to a signaling standard of a circuit-switching communication network" in combination with the claimed "at least one part of the first signaling information is transmitted between the network element and the first subscriber such that the at least one part is configured according to the signaling standard of the circuit-switching communication network as well as in the packet switching communication network" is confusing. More specifically, as best understood from the claim language, reference is made to signaling information part that is configured to circuit-switching standard and packet switched standard, the configuration of the same signaling information using two different standard while using a transmission medium that uses only one standard is confusing, because in the act of "transmission of data" between the network element and the subscriber only one medium is used that can support only one standard protocol and not both protocols.

In addition to the above, it is not clear what is meant by "at least one part of the first signaling information is configured according to the signaling standard of the circuit-switching communication network as well as in the packet switching communication network". More specifically, while the meaning of "the one part of the first signaling information is configured according to the signaling standard of the circuit-switching communication network" is clear, the meaning of "as well as the in the packet switching communication network" is not, clear reference to whether the one part is configured also according to the packet-switching standard.

Claims 2-18 depends from claim 1, thus they are subject to the same rejections.

Regarding claim 19, claim 19 suffers from the same deficiencies as in claim 1.

Claims 1 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The entity responsible for initiating the signaling information that is transmitted between the subscriber and the network element, such element is required to link the other claimed "element" with each other, because it is not clear which part does transmit the signaling information, and what causes such transmission to occur.

#### ***Claim Rejections - 35 USC § 102***

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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3. Claims 1, 2, 3, 4, 6, 10, 11, 12, 14, 17, 18 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by the Admitted Prior Art discussed in the present application, hereinafter referred to as APA.

Referring to claims 1, 2, 3, 4, 6, 10, 11, 12, 14, 17, 18 and 19, APA discloses a telecommunications system having a packet-switching communications network, comprising at least a first subscriber connected to the packet-switching communications network (terminals are connected to a packet switched network (see pages 2 and 3)) and a network element of a circuit switching communications network connected to the packet-switching communications network using an interface unit (a gateway is connected between the packet switched network and a circuit switched network (see pages 2 and 3)), wherein first signaling information is transmitted between the network element and the first subscriber (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS 1 messages to H.323/H.225 messages (see pages 2 and 3)), the first signaling information corresponding to a signaling standard of a circuit-switching communications network (the first signaling is DSS 1 signaling which corresponds to circuit switched networks (see pages 2 and 3)).

wherein the first signaling information corresponds to a DSSI signaling protocol (the first signaling is DSS I signaling which corresponds to circuit switched networks (see pages 2 and 3)).

wherein a portion of the first signaling information is converted into second signaling information using the interface unit and is transmitted as second signaling

information between the interface unit and the first subscriber (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS 1 messages to H.323+.225 messages (see pages 2 and 3);

wherein the second signaling information corresponds to an H.323/H.450 signaling protocol (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSSI messages to H.323 messages (see pages 2 and 3));

wherein the interface unit converts the first signaling information of the network element into second signaling information, and further converts the second signaling information into the first signaling information (user-channel-related signaling messages are transmitted between the terminal and the gateway that converts DSS1 messages to H.323 messages and vice versa (see pages 2 and 3)), the first signaling information signaling information of the circuits switching communications network which can be converted the second signaling information (the first signaling is DSS1 signaling which corresponds to circuit switched networks (see pages 2 and 3));

wherein user data is transmitted using the network element when there is a connection between the first subscriber and at least one second subscriber. (the system is used for transmitted information between subscribers since this is what the H.323 standard is for (see pages 2 and 3)), wherein the user data is transmitted directly between the first and second subscribers using the packet-switching communications network when there is a connection between the first subscriber and the at least one second subscriber of the packet-switching communications network (the system is used

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for transmitted information between subscribers since this is what the H.323 standard is for (see pages 2 and 3)).

wherein a call number is assigned to the first subscriber in the network element, the first subscriber in the packet-switching communications network has a subscriber address, and wherein the assignment between the subscriber address and the call number is made using a control unit (the subscribers have addresses and the gatekeeper assigns addresses (see pages 2 and 3));

wherein the packet-switching communications network is a data network which is based on an Internet protocol, and the first subscriber is an IP terminal (the packet network is the Internet and thus the terminal connected to it is an IP terminal (see pages 2 and 3));

wherein the first subscriber sets up a voice connection to a second subscriber (the H.323 standardized protocol is used for setting up voice calls through the Internet (see pages 2 and 3)).

wherein the second signaling information is transmitted using signaling packets of the packet-switching communications network and wherein the first signaling information is transmitted using a data area of the signaling packets which does not contain any second signaling information (the terms 'data area' taken broadly can merely mean bit position in a packet and since any one bit position can only hold one bit, that bit must be related to either the first or second signaling bits that are being converted by the gateway and thus inherently the signaling bits of one are not in the data area of the other).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 5, 9, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA.

Referring to claims 5 and 9, APA discloses the system discussed above. APA does not disclose that the second signaling information corresponds to a SIP signaling protocol nor does the APA disclose that the signaling between the subscribers uses the tunneling principle. However, as pointed out in the specification on page 6, SP is an established standard and tunneling is also an established communications standard. Thus, it would have been obvious to one skilled in the art at the time of the invention to implement SIP and tunneling in the APA because doing so would reduce production costs since SIP and tunneling are already established standards.

Referring to claims 15 and 16, APA discloses the system discussed above. APA does not disclose that the first subscriber is administered as a subscriber with one of an ISDN basic access and a broadband ISDN access in the network element and that the ISDN access is one of an ISDN access in point-to-point configuration and an ISDN access in point-to- multipoint configuration. However, ISDN and this configuration are

established standards. Thus, it would have been obvious to one skilled in the art at the time of the invention to implement this standard in the APA because doing so would reduce production costs.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Klaghofer et al. (USPN 6,466,662), hereafter referred to as Klaghofer.

Referring to claims 7 and 8, APA discloses the system discussed above. APA does not disclose that a feature is provided to the subscriber that cannot be used by the second signaling information nor does disclose any particular feature. However, Klaghofer discloses a system wherein at least one service or feature which cannot be used by the second signaling information is made available for use to the first subscriber via the first signaling information (a call transfer procedure cannot normally be performed using H.323 related signaling (see column 1)) and the service or feature is at least one of call pick-up, call divert, call forwarding, call name display, subscriber cut-in, subscriber-dependent ringing, three-way conferencing, large-scale conferencing, holding, displaying of toll information, a closed user group, a private call number schedule, call number identification, automatic callback when busy, automatic callback when no reply, call barring, call waiting and call transfer (the feature is a call transfer feature (see column Page 7 1)).

6. Claim 13, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Swartz et al. (USPN 6,330,244), hereinafter referred to as Swartz.

Referring to claim 13, APA discloses the system discussed above. APA does not disclose that the first subscriber assumes one of main line functions and an extension function. However, Swartz discloses a system wherein line extensions are used to implement PBX functions over the H.323 protocol (see columns 11 and 12)) (claimed main line function and extension function). It would have been obvious to one skilled in the art at the time of the invention to implement this feature into the APA because doing so would make the system more flexible by using extensions and would also allow the system to cooperate with existing PBX systems thereby making the system more versatile.

#### ***Response to Arguments***

7. Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive:

Applicants argue that the APA (admitted prior art) does not disclose the "*relevant part of the signaling information is encoded according to the same rules in the circuit-switching communication network and in the packet-switching communication network. As such, such signaling information has an identical format in both of the claimed networks so that there is no necessity for a conversion of data between the two different formats*" (emphasis added). Examiner notes that the claims as amended do not comprises this distinction over the ADA. Applicants argue that in ADP, *the first bits of*

*signaling information are transmitted in the associated circuit-switching communication network, which are configured according to a signaling standard of the circuit-switched communication network and the second bits of signaling information are transmitted in the packet-switching communication network, which are configured according to a signaling standard of the packet communication network, An interface thereafter is necessary between the two networks for conversion between the two different bits of signaling information”* (page 8). Examiner however notes that Applicants last argument in which they assert that an interface is required for the conversion of the signaling bits in the ADA is also used by Applicant, for example in pending claim 3, it is recited that “*a portion of the first signaling information is converted into second signaling information using the interface unit and is transmitted as a second signaling information between the interface unit and the first subscriber*”. Examiner concludes that the claimed portion in claim 3 with can be interpreted as the same “first signaling information” as in claim 1, and the interface required for the conversion (in claim 3) contradict Applicants own argument.

Examiner concludes that the claims as amended do not specify the alleged differences between the admitted the prior art. And that given a reasonable interpretation of the claim limitations, the rejection above is proper.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Huang et al, US (6,687,747).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM  
Examiner  
Art Unit 2662  
June 24, 2005



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